

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of: Czaplicki et al.

Group Art Unit: 1828

Serial No.: 10/806309

Examiner: Robert E. Sellers

Filed: March 22, 2004

For: SYNTHETIC MATERIAL AND METHODS OF FORMING AND APPLYING SAME

Attorney Docket No.: 1001.112c1

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

CERTIFICATE OF MAILING/TRANSMISSION (37 C.F.R. section 1.8(a))

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(type or print name of person certifying)

**ELECTION REQUIREMENT PURSUANT TO 35 U.S.C. 121 AND AMENDMENT AND
RESPONSE**

Dear Sir:

This response addresses the Election/Restriction requirement dated June 22, 2006 with respect to the above-identified patent application. Applicants elect, with traverse, to proceed with Invention I, which is indicated by the Requirement to include claims 20-24, 27-32 and 34-36. Applicant further elect, with traverse, to proceed with species as follows: (a) bisphenol A epoxy resin; (b) base materials including blowing agent; (c) correspondence components including a bisphenol A epoxy resin; and, if necessary (d) curing agent being a dicyandiamide. Such species election includes claims 20-35 and 37-43. As such, the elected claims are 20-24,

27-32 and 34-35 if both the Restriction and Election of species are maintained, however, Applicants specifically assert that the Restriction between inventions I, II, III and IV should be withdrawn.

Applicants specifically traverse the restriction requirement, which requires Applicants to elect between Inventions I, II, III, or IV as indicated by the Office Action. A restriction requirement is only proper where the inventions of the different claims can be shown to be independent or distinct. Applicants contend that the Inventions as divided by the Restriction Requirement are not independent. Applicants contend that, if the restriction requirement is maintained, the examiner is acknowledging that Inventions II, III and IV are patentable over the invention of claim I and Applicants specifically reserve the right to enter language of Inventions II, III and IV. Applicants further assert that the Restriction of Inventions I, II, III and IV should be withdrawn since a search of each of the claims presently pending would not be overly burdensome.

Independent

The MPEP, at section 802.01, defines the term "independent" as meaning that, "there is no disclosed relationship between the two or more subjects disclosed, that is, they are unconnected in design, operation or effect ..." However, there is a relationship between the Inventions I, II, III and IV. In particular, the method of present claim 20, indicated as being invention I, includes the steps of 1) providing a polymeric base material ...; 2) providing a polymeric powder ...; 3) dispensing the powder upon the base material to form the synthetic material ... and 4) applying the synthetic material. The specification and claims of the present application make clear that, in a preferred embodiment of the invention of the present application, the base material of invention I can include a curing agent, which is indicated to be

the subject matter of invention III, and formation and/or application of the synthetic material of invention I can include temporary application of release paper, which is the subject matter of inventions II and IV. As such, Inventions I, II, III and IV are clearly related such that they are not independent as that term is used in the MPEP.

Distinct

The MPEP, at 802.01, defines the term “distinct” as meaning that the subject matters of the restriction are “PATENTABLE (novel and unobvious) OVER EACH OTHER ...” Thus, since Inventions I, II, III and IV are related (i.e., not independent), Applicants suggest that maintaining the Restriction between those inventions suggests that the Invention I, II, III, IV are “distinct” and is therefore acknowledgement that the subject matter of Inventions II, III and IV are patentable over the subject matter of Invention I. As such, Applicants specifically reserve the right to enter language suggesting that the base material or the powder is thermosettable and/or includes a curing agent and/or language suggesting the use of release paper and that, maintenance of the Restriction would acknowledge the patentability of that language as added to claim 1 unless such language is specifically taught by the prior art as part of Invention I.

Serious Burden

The MPEP, at 803, reads that “If the search and examination of an entire application can be made without serious burden, the examiner must examine it on the merits, even though it includes claims to independent or distinct inventions.” Regardless of whether Inventions I, II, III and IV are independent or distinct, Applicants contend that the Restriction to these inventions should be withdrawn since search of each of the Inventions does not present a serious burden.

In particular, the Examiner has indicated that Inventions I, II, III and IV are each in class

156. The basis then for the restriction appears to be that Invention II, III and IV are in different subclasses within Class 156. Applicants assert, however, that a search for curing agent and/or release paper (i.e., the subject matter of inventions II, III and IV) within a single class does not present a serious burden. This is particularly the case since none of the Inventions are deemed to be outside of class 156 and since the relatively small subclasses or areas (i.e., subclasses 323, 307.1 and 327) to search within class 156 have already been identified. On these grounds, Applicants request that the Restriction to Inventions I, II, III and IV be withdrawn.

The Election/Restriction requirement also pointed out that the specification has not been amended to properly identify the present application as a continuation of a prior application. Such a revision has been added to the specification by the Amendment, which is on the following pages.

The Election/Restriction requirement also suggested that the specification lacked support for the term "baffling" in the claims. Without acquiescing in this suggestion, Applicants have remove the term "baffling" from the claims by the Amendment, which is on the following pages.

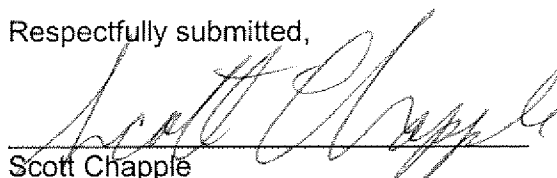
The Election/Restriction requirement also suggested there is no antecedent basis in claim 20 for "the contacting of the non-tacky surface" in claim 22 wherefrom it depends. However, Claim 22 is dependent upon claim 21, which provides such antecedent basis.

If the Examiner has any questions with respect to this communication, the Examiner is kindly urged to call the undersigned.

If for some reason Applicants have not requested a sufficient extension and/or have not paid a sufficient fee for this response and/or for the extension necessary to prevent the abandonment of this application, please consider this as a request for an extension for the required time period and/or authorization to charge our Deposit Account No. 50-1097 for any fee which may be due.

Respectfully submitted,

Dated: 12 July, 2006



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